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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,937	08/15/2001	Loretta D. Spotila	DRE-0057	7842

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EXAMINER

JOHANNSEN, DIANA B

ART UNIT PAPER NUMBER

1634

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

5-17

**Advisory Action**

SM

Applicant(s)

09/856,937

SPOTILA, LORETTA D.

Examiner

Diana B. Johannsen

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: Interview Summary attached.

Continuation of 5. does NOT place the application in condition for allowance ~~because:~~ for the reasons set forth on the attachment to this Advisory Action and for the reasons of record in view of the non-entry of the After Final amendment .

**ATTACHMENT TO ADVISORY ACTION**

***New issues raised.***

1. Applicant's proposed amendments raise the following new issues under 35 U.S.C. 112, second paragraph that would require further consideration. Applicant has proposed amending claim 1 to recite the limitation "a polymorphism at position 593, 598 or 620 of exon 10 (SEQ ID NO: 1) of the TNFR2 gene." First, as SEQ ID NO: 10 does not in fact correspond to exon 10, but rather to a portion of intron 9 as well as exon 10, it is unclear as to what polymorphisms are encompassed by the claim (i.e., is the claim drawn to positions 593, 598 and 620 of exon 10, or to positions 593, 598 and 620 of SEQ ID NO: 1)? Further, it is unclear as to how the recitation of SEQ ID NO: 1 limits the claim. For example, does detection of polymorphisms at positions 593, 598 and/or 620 require detection of SEQ ID NO: 1 itself, or is the detection of a portion of this sequence sufficient to determine the presence of the polymorphisms? Further, in the absence of detecting SEQ ID NO: 1, how would one of skill conclude that any identified polymorphism is a polymorphism "at position 593, 590 or 620" of SEQ ID NO: 1? Clarification is required.


***Conclusion***

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 703/305-0761 through January 13, 2004, and 571/272-0744 beginning January 14, 2004. The examiner can normally be reached on Monday-Friday, 7:30 am-4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached at 703/308-1152 through January 13, 2004, and 571/272-0745 beginning January 14, 2004. The fax phone number for the organization where this application or proceeding is assigned is 703/872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-1234.

A handwritten signature in cursive script, appearing to read "Diana B. Johannsen", followed by a long horizontal flourish.

Diana B. Johannsen  
Patent Examiner  
January 5, 2004